

rotating comprising at least one handle attached to one of said shearing elements.--

Cancel claim 12, without prejudice.

REMARKS

Claim 6 has been amended. Claim 12 has been canceled. Claims 6-8 and 13-16 remain pending. Of these, the Examiner has withdrawn claims 13 and 14 from consideration as being directed to an invention that is allegedly independent or distinct from the invention originally claimed because they are directed to different disclosed species as described in the restriction requirement (paper #3).

Claim 6 is the only independent claim presently pending. It is urged to be generic to the subject matter of claims 13 and 14 and to be in condition for allowance. Accordingly, claims 13 and 14 are urged to be proper and to be allowable.

Claim 12 was rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection went on to state that the specification and drawings did not appear to provide support for shearing elements which each comprise a disc (claim 7) in combination with each shearing element comprising one of a pair of forceps as set forth in claim 12. Rather, the rejection stated, support is provided

for the shearing elements comprising either a disc or forceps, but not both.

Claim 12 has been canceled herein, without prejudice, to simplify the issues. All Section 112 issues have now been removed.

Independent Claim 6

As now presented, claim 6 has been further amended to provide that the axis for rotating the shearing elements counter to one another be situated so as to cut the plane which extends between the cutting edges of the shearing elements. It is urged that this additional feature of claim 6 now further distinguishes the claims from the references and from any combination thereof relied on in the last Action.

The following numbered paragraphs respond to the like-numbered paragraphs in the Action of 06/03/98.

4.-5. Claims 6, 8 and 15 were rejected under 35 U.S.C. §102(b) as being anticipated by Shearer (U.S. Pat. No. 1,471,422). According to the rejection, Shearer discloses a cutting tool which meets every structural limitation of the then-pending claims 6, 8 and 15 in the manner as Figure 3, wherein the cutting tool includes a cutting element and a handle attached thereto. The rejection also stated that using two of these cutting tools to form the claimed hand-held tool, whereby the sides having the cutting edges are held so that they are directly touching each other, is considered a functional recitation of intended use of the cutting tool (i.e., it is considered an intended use of the forceps of Shearer).

The rejection is respectfully traversed.

As will be seen from the language of claim 6, the rotating axis of the claimed device passes through (cuts) the plane which extends between the cutting edges of the shearing elements. That is, the above-described rotating axis of the device passes through the opening between the cutting edges. This relationship therefore provides for the application of torsional shearing by transverse forces applied to the body being acted on. The Shearer reference does not disclose or suggest such an arrangement. Accordingly the anticipation rejection of independent claim 6 and dependent claims 8 and 15 is overcome. As will best be seen in Fig. 3 of Shearer, the plane of cutting edges 8 is not intersected in the presently claimed fashion by the axis of rivet 7. Nor does the Shearer reference suggest any modification which would have motivated one of ordinary skill in the art to have made the device of the present claims. Likewise, Shearer does not disclose or suggest the selection of a pair of forceps as claimed in claims 8 and 12.

6. Claims 6-8, 12, 15 and 16 were also rejected under 35 U.S.C. §102(b) as being anticipated by British Patent 20,244. The rejection went on to state that British 20,244 discloses a cutting tool in Figures 1-5 (particularly as shown in Fig. 3) with every structural limitation of the claimed invention...including a disc (e.g., E, K, I) having a slot (e.g., formed by K and I) forming a cutting edge at one side of the disc (e.g., the right side as viewed in Fig. 2), and a handle (e.g., A, C) connected to the disc. The rejection also stated that it

was noted that using two of these cutting tools to form the claimed hand-held tool, whereby the sides having the cutting edges are held so that they are directly touching each other, was considered a functional recitation of the intended use of the cutting tool (i.e., it is considered an intended use of the cutter of British 20,244).

This rejection is respectfully traversed as well.

As was noted earlier, claim 6 is the only independent claim now pending. The claim calls for the rotating axis of the claimed device to pass through (cut) the plane which extends between the cutting edges of the shearing elements. Again, this clearly distinguishes the claimed device from the British 20,244 reference. The rotating axis is clearly shown as being besides or outside the plane extending between the cutting edges of the shearing elements. In Fig. 3, for example, stud F is the pivot (page 1, lines 33-34) while jaw I and jaw K (page 1, lines 37-44) provide the cutting surfaces. As is clearly illustrated, the rotating axis passes beside (not through) the defined plane. Independent claim 6 and dependent claims 7-8, 12, 15 and 16 are not anticipated. Nor does British 20,244 suggest any modification which would have motivated one of ordinary skill in the art to have made the device of the present claims. Accordingly, the anticipation rejection of the claims is overcome.

7.-8. Claim 6 was rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Stolpe (U.S. 690,083).

The rejection states as follows:

"Stolpe discloses a cutting apparatus (e.g. in Figure 2) with every structural limitation of the claimed invention including an upper shearing element (connected to e'), a lower element (connected to f'), and a means (e.g. b,1',1') for rotating the elements counter to one another.

"In the alternative, if it is argued that Stolpe does not include handles which are to be grasped by hand, it is the Examiner's position that the threaded/linkage mechanism (e.g., p,q,r,s,t) of Stolpe is provided to obtain a mechanical advantage to facilitate rotation of the arms/handles (e.g., g,o). It is known to those skilled in the art that mechanisms used to gain mechanical advantage have there cost. One "cost" is reduced speed of operation. Therefore, it would have been obvious to one having ordinary skill in the art, when using the device of Stolpe to cut softer material (e.g., soft iron or iron products) to remove the linkage from the arms/handles of Stolpe so that they can be pivoted more quickly and improve manufacturing efficiency (i.e., cut workpieces more quickly)."

We respectfully transverse.

First, as has been previously pointed out, the words "A hand-held tool" in line 1 of claim 6 constitute a limitation distinguishing the cited prior art and that limitation is "structural." Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the

specification and illuminated in the prosecution history. See *Applied Materials Inc. v. Advanced Semiconductor Materials*, 98 F.3d 1563, 1573, 40 U.S.P.Q.2d 1481, 1488 (Fed. Cir. 1996). Applicants' position is not affected by the fact that the present claims are directed to a device instead of a process. The claim must be viewed as a whole. In the present case, it is clear from the specification and from our previous amendment dated February 26, 1997 that the limitation to "hand-held" defines the invention that is claimed. This would require construing the literal meaning of the claims as limited to hand-held tools for the purposes of patentability. Accordingly, it is proper to use this limitation to distinguish the claimed invention from the cited prior art, which does not appear to disclose a "hand-held tool" by any stretch of the imagination.

Further, the phrase "hand-held tool" is a structural limitation, because it connotes a size and weight limitation to those skilled in the art.

Second, claim 6 includes the limitation: "said means for rotating comprising at least one handle attached to one of said shearing elements." This limitation is generic to the embodiments of Figs 2a-2c and 3-5.

We recognize that the office action in paragraph 9 has taken the position that the elements identified by the characters (e', f') of Stolpe are "handles." Applicants respectfully disagree. Stolpe describes elements e' and f' as "arms." (Page 2, line 10, referring to Fig. 6) Neither the figures nor the descriptions of those elements disclose what one skilled in the

art would understand to be "handles." For example, the relevant definition of the noun "handle" in Webster's Ninth New Collegiate Dictionary, p. 550 (1983) is

1: a part that is designed esp. to be grasped by the hand....

We further point out that, pursuant to *Markman v. Westview Instr. Inc.*, 52 F.3d 967, 34 USPQ 2d 1321 (Fed. Cir. 1995) (*en banc*), *aff'd* 116 S.Ct. 1384, 38 USPQ 2d 1461 (1996) and *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 39 USPQ 2d 1573 (Fed. Cir. 1996), if the claims are allowed on the basis of Applicants' arguments, they will be construed in the light of the successful arguments. Applicant's pending claim 6 (and the other claims) clearly distinguish over Stolpe. This rejection has been overcome.

It is respectfully urged that the Examiner's "alternative" argument is not well taken. Assuming for the sake of argument, that one of ordinary skill in the art were to be motivated as suggested by the Examiner (which the applicants maintain would not be case), it is not seen that the device with elements p, q, r, s and t removed would lead to the applicants' claimed device. The revised Stolpe device would still not be a hand-held tool. Furthermore, one of the Stolpe knives, knife k, is arranged stationarily in Fig. 1, unlike the device of the present claims. Stolpe's Fig. 6 embodiment is said to have two rotatable knives, but they are designed and operated so as to force the knives into the iron rod being cut. The device of the present claims, however, calls for applying a torsional shearing

force about the axis of the body being cut, thus twisting a portion of that body relative to the rest. Stolpe's device does not operate in this fashion now, nor would it as modified in accordance with the Examiner's "alternative" argument. It is urged that the claims now pending clearly distinguish over this "modification" of Stolpe as well.

9. Claim 7 was rejected under 35 U.S.C. §103 as being unpatentable over Stolpe (U.S. 690,083) in view of Schweitzer (U.S. 4,887,447).

The rejection states as follows:

"Stolpe discloses a cutting apparatus (e.g. in Figure 2) which discloses or suggests almost every structural limitation of the claimed invention including a handle (e',f') attached respectively to each shearing element but lacks each shearing element comprising a disc having a slot with a cutting edge extending from the outer periphery toward the center. Schweitzer discloses a cutting apparatus wherein the shearing elements each include a disc having a slot with a cutting edge as claimed wherein the slot narrows towards the center, and teaches that peripheral slots are provided for inserting lengths of rebar therein for cutting the rebar. Therefore, it would have been obvious to one having ordinary skill in the art to provide the discs of Schweitzer with slots therein on the cutting apparatus of Stolpe to gain the benefits taught by Schweitzer including that described above."

We respectfully traverse.

First, Applicants submit that their claims are distinguished from the cited references, *inter alia*, for the reasons discussed above. Second, it is not seen that there is any suggestion in either reference to combine the two references as set forth in the rejection. In particular, neither reference alone or in combination suggests Applicant's advantageous, claimed hand-held tool, and neither suggests applicant's handles attached to the shearing elements, a limitation now included in all claims.

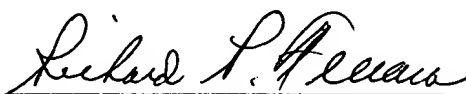
10. It is not seen that separate comments are needed with respect to paragraph 10 of the Action in view of applicants' remarks made above.

Conclusion

The pending claims now overcome all the objections/rejections made in the last Official Action. Allowance of claims 6-8 and 13-16 is appropriate and is urged.

Respectfully submitted,

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